

REMARKS

This paper is submitted in response to the Office Action for the above-identified application mailed 9 November 2007. In the Office Action, Claims 71-73, 76, 79, 80, 89-93, 95, 99-101, 103 and 104 were rejected under 35 U.S.C. 103 for being obvious over Malackowski, U.S. Pat. Pub. No. 2001/0034530 in view of Adair, U.S. Pat. No. 5,873,814. Claims 75, 78, 97 and 98 were rejected under the same statute over the above documents further in view of U.S. Pat. Pub. No. US 2002/0035321 to Buchloz.

It was stated in the Office Action that Claims 102 and 105 are directed to a patentable invention. The Applicants thank the Examiner for the favorable review of these claims. Nevertheless, at this time, for the reasons set forth below, the Applicants request reconsideration of the above rejected claims.

Claim 80 was rejected under 35 U.S.C. Sec. 112 for failing to particularly point out and distinctly claim the subject matter the Applicants regard as the invention. Under cover of this Response, the Applicant has amended Claim 80 to rectify the matter giving rise to this rejection.

The present 35 U.S.C. Sec. 103 rejection is based on the position that the '530 Publication discloses sharing power between a powered surgical handpiece and a removable tracker attached to the handpiece. The Response and Malackowski Declaration both of 27 September 2008 describe why this feature was not disclosed by the '530 Publication.

The present rejection is based on the position that

Malackowski Declaration failed to satisfactorily prove that the '530 Publication does not disclose power sharing. In the Office Action, it was stated that the Malackowski Declaration was moot because the powered tool discussed in the Declaration is one that consumes a large amount of power.

The above conclusion ignores facts relevant to both the '530 Publication and the Malackowski Declaration. First, with regard to the '530 Publication, there is no disclosure anywhere in this document of an assembly for sourcing power from one of the handpiece or the removable tracker to the other of these two units. Secondly, as set forth in the Malackowski Declaration, at the time the removable tracker that is the subject of the '530 Publication was constructed, there were no efforts made to provide for such power sharing.<sup>1</sup>

Accordingly, Applicants maintain that there is nothing in '530 Publication that either teaches or suggests power sharing between a powered surgical handpiece and the tracker removably attached to the handpiece.

The Applicant further notes that there is nothing in the '530 Publication that suggests power sharing when the powered tool and tracker are a single assembly. The "smart instrument" of this publication is one of two types of assembly. One assembly is the non-powered instrument such as the pointer 600 of Figures 6-8 that includes built-in tracker 102. The second type of smart instrument is any

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<sup>1</sup> Malackowski Declaration of 27 September 2007, paragraph 6.

instrument to which the universal tracker 200 is attached.<sup>2</sup> With regard to this latter type of smart instrument, the '530 Publication makes it clear that the tracker 200 is provided to allow common surgical instruments to be used with the surgical navigation system 100.<sup>3</sup>

The '530 Publications states that the smart instrument may include some sort of power consuming unit. However, nowhere does it state or suggest in this document that a single power source can be used to source power to both the power generating unit of the instrument and the complementary tracker. Again, the present claims are not directed to an assembly that includes any tracker; they are directed to an assembly that includes a *removable* tracker.

If the Office is of the opinion that handpiece-tracker power sharing is disclosed in the '530 Publication, the Applicants request that this teaching be pointed out with specificity.

The only disclosure of power sharing between the powered surgical handpiece and its tracker is the teaching in the present application. Nowhere in the application do Applicants state this power sharing technique was known in the prior art. Therefore this statement does not fall under the provision of the *Manual of Patent Examining Procedure*, Sec. 2129, that allow it to be considered prior art.

Adair discloses an assembly wherein cabling is used to source power to his display. Bucholz is directed to a method of processing navigation data. Accordingly, these

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<sup>2</sup> U.S. Pat. Pub. No. US 2001/0034530 A1, paragraph 62.

<sup>3</sup> U.S. Pat. Pub. No. US 2001/0034530 A1, paragraph 64.

documents, like the '530 Publication, fail to suggest power sharing between a battery-powered surgical handpiece and a tracker that is removably attached to the handpiece.

Thus, even when summed together, the prior art does not equal the assembly having either the features of benefits of Applicants claimed invention. Each of the claims is therefore directed to an assembly entitled to patent protection.

Accordingly, since the claims and the other parts of this application are in an allowable state, the Applicant courteously solicits prompt issuance of a Notice of Allowance.

Respectfully submitted,

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